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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,099	10/03/2007	Jeung-Yeup Son	038779/314156	1742
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ALSTON & BIRD LLP			HUANG, TSAN-YU J	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/586,099	SON, JEUNG-YEUP
	Examiner	Art Unit
	TSAN-YU JAY HUANG	3685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 20 November 2009.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
 4a) Of the above claim(s) 6-11 and 13-20 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-5 and 12 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/14/06</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Acknowledgements

This Office Action is in response to the original application filed on November 20, 2009.

The Examiner notes that United States Patent Application Publication paragraph numbers in the Office Action will be referred to as [####], #### representing the paragraph number.

The Examiner notes that an ellipsis (...) marks an intentional omission of a phrase from the original text, and is not shorthand for the actual phrase.

The Examiner notes that the usage of "etc" marks a continuation of the phrase from the original text.

Status of Claims

Claims 1-5, 12 are elected with traverse by Applicant.

Claims 6-11, 13-20 are withdrawn from consideration.

Claims 1-20 are currently pending and have been examined.

Claims 1-5, 12 are rejected as set forth below.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 1-5, 12** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

3. **Regarding claim 1**, the claimed invention discloses an electronic transaction system that includes "a message sender", "a transaction history sender", "a certifier", and "a service provider" which can be interpreted as a human being. If the broadest reasonable interpretation of the claimed invention encompasses a human being, then a rejection under 35 U.S.C. 101 must be made indicating that the claimed invention is directed to nonstatutory subject matter. See *MPEP §2105*. The rejection applies to dependent **claims 2-5**.

4. **Regarding claim 12**, the invention is rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008). An example of a method claim

that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed. In this particular case, claim 12 fails prong (1) because the limitations are not tied to a **positively recited** statutory class. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claims 1-5** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. **Regarding claim 1**, the claimed invention discloses an electronic transaction system that, giving the claim its broadest reasonable interpretation, certain limitations read on a computer program. For example, the “message sender”, “transaction history sender”, “certifier”, and “service provider” are interpreted as software modules. Computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical “things.” They are neither computer components nor statutory processes, as they are not “acts” being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computer program’s functionality to be realized. See *Lowry*, 32 F.3d at 1583-84, 32 U.S.P.Q. 2d at 1035. The rejection applies to dependent **claims 2-5**.

8. **Regarding claim 2**, the invention purports to be both a product or machine and a process and therefore is ambiguous. It has been held that a claim that recites both an apparatus and a method for using said apparatus is indefinite under section 112, paragraph 2, as such a claim is not sufficiently precise to provide competitors with an accurate determination of the 'metes and

bounds' of protection involved . For example, the limitation "wherein the transaction history sender uses the phone number, etc." is a method step. See *MPEP 2173.05(p) II; IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990)

9. **Regarding claim 3**, the invention purports to be both a product or machine and a process and therefore is ambiguous. It has been held that a claim that recites both an apparatus and a method for using said apparatus is indefinite under section 112, paragraph 2, as such a claim is not sufficiently precise to provide competitors with an accurate determination of the 'metes and bounds' of protection involved . For example, the limitation "wherein the certification mobile terminal receives a digital certificate, etc." is a method step. See *MPEP 2173.05(p) II; IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990)

10. **Regarding claim 5**, the invention purports to be both a product or machine and a process and therefore is ambiguous. It has been held that a claim that recites both an apparatus and a method for using said apparatus is indefinite under section 112, paragraph 2, as such a claim is not sufficiently precise to provide competitors with an accurate determination of the 'metes and bounds' of protection involved . For example, the limitation "wherein the message is transmitted, etc." is a method step. See *MPEP 2173.05(p) II; IPXL Holdings LLC v. Amazon.com Inc.*, 77 USPQ2d 1140 (CA FC 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (B.P.A.I. 1990)

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claims 1-2, 4, 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent Application Publication No.

2003/0191721 to *Fiammante*, in view of United States Patent Application Publication No. 2001/0037264 to *Husemann*.

13. **Regarding claims 1 and 12**, *Fiammante* teaches:

An electronic transaction system, being connected to a transaction terminal and a certification mobile terminal through a network and performing transactions according to a user request, comprising:

a transaction processor for performing a transaction according to a request provided by the transaction terminal; (Figure 1, [0020] – [0022])

a message sender for receiving a transaction history... from the transaction terminal and a mobile phone number, and transmitting a message which notifies receipt of the transaction history to the certification mobile terminal corresponding to the mobile phone number; (Figure 1-2, [0026] – [0030])

a transaction history sender for providing the transaction history to the certification mobile terminal...; (Figure 1-2, [0026] – [0031])

Fiammante does not explicitly disclose providing data to a terminal when the terminal performs an access on the data sender. However, the Examiner takes Official Notice that providing data to a terminal when the terminal performs an access on the data sender is old and well known. Therefore, as *Fiammante* teaches providing data to a terminal, a predictable result would have been to provide data to the terminal when the terminal performs an access in order to provide the data only when the terminal requests it.

a certifier for receiving the digitally signed transaction history from the certification mobile terminal, and verifying the digitally signed transaction history; (Figure 1-2, [0031] – [0033]) and

a service provider for providing a service corresponding to the transaction to the transaction terminal when the transaction history is verified. (Figure 1, [0020] – [0022]; [0033])

Fiammante does not explicitly teach receiving a mobile phone number from the transaction terminal.

However, *Husemann* teaches receiving a mobile phone number from the

transaction terminal. (Figure 4, [0054])

One of ordinary skill in the art at the time of the invention would have been motivated to modify *Fiammante* with the features taught by *Husemann* because modifying the message sender to receive the mobile phone number from the transaction terminal ensures that the customer's most current mobile phone number is used, thus increasing the quality of service of the invention.

14. **Regarding claim 2,** *Fiammante* and *Husemann* disclose the invention as claimed. See the discussion of claim 1.

Fiammante further teaches transmitting the transaction history to the certification mobile terminal. (see the discussion of claim 1)

In addition, *Husemann* further teaches:

a history database for storing mobile phone number and corresponding transaction histories for respective users, wherein the transaction history sender uses the phone number of the accessing certification mobile terminal to find a corresponding transaction history from the history database. ([0065])

15. **Regarding claim 4,** *Fiammante* and *Husemann* disclose the invention as claimed. See the discussion of claim 1.

Applicant attempts to further limit the electronic transaction system by describing characteristics of the message. However, this is representative of non-functional

descriptive material as characteristics of the message is not functionally related to the electronic transaction system (MPEP 2106 II; *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994)) and therefore cannot be used to differentiate Applicant's invention from the prior art invention.

Art Unit: 3685

16. **Claim 3** is rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent Application Publication No. 2003/0191721 to *Fiammante* in view of United States Patent Application Publication No. 2001/0037264 to *Husemann*, and further in view of United States Patent Application Publication No. 2002/0198849 to *Piikivi*.

17. **Regarding claim 3**, *Fiammante* and *Husemann* disclose the invention as claimed. See the discussion of claim 1.

None of the references explicitly teach:

a certification authority server for issuing digital certificates, wherein the certification mobile terminal receives a digital certificate from the certification authority server.

However, *Piikivi* teaches:

a certification authority server for issuing digital certificates, wherein the certification mobile terminal receives a digital certificate from the certification authority server. ([0044] – [0045])

One of ordinary skill in the art at the time of the invention would have been motivated to modify *Fiammante* and *Husemann* with the features taught by *Piikivi* because modifying the electronic transaction system to include a certification authority server for issuing digital certificates ensures the alleged parties are indeed who they say they are, thus increasing the security of the invention.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

The reference *Ginter* (United States Patent Application Publication No.

20020112171) teaches sending data when requested.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TSAN-YU JAY HUANG whose telephone number is (571)270-7039. The examiner can normally be reached on Monday to Friday, 9:00 am - 5:00 pm Eastern Standard Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt, II can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/TSAN-YU J HUANG/
Examiner, Art Unit 3685
January 19, 2010

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685